Remarks

A RCE under 37 C.F.R. § 1.114 is filed to submit corresponding patent publications to those Japanese Patent Publications cited by the Japan Patent Office.

Claims 19 and 145-156 are pending.

Claims 145-156 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,393,763 (Black).

Claims 19 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Black as applied to claims 145-156.

U.S.C. § 102(b) Rejection

Claims 145-156 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,393,763 (Black).

In the Office Action of April 11, 2008, the Examiner stated

> Black *et al.* provides methods for inhibiting the loss of bone and are thus effective for the treatment of osteoporosis (Abstract). One of the most common types of osteoporosis is found in post-menopausal women (col. 1, lines 34-35). The methods of the invention comprise administering an effective amount of a compound of formula I as recited in column 2, lines 25-59. Such compounds include raloxifene as instantly claimed (cols. 7-8 and Examples). Doses of 0.1 to 1000 mg and more typically from about 200 to 600 mg are administered (col. 6, line 68 to col. 7, line 5). The instantly claimed dose is "about 60 mg". The "about" modifier expands the range of raloxifene that can be administered to a patient to reasonably include any effective amount, including those doses recited in Black *et al.* In the examples provided in the reference, raloxifene is administered to "post-menopausal women" (col. 19, lines 15-16 and claim 3), thus teaching the instantly claimed patient population. Claim 2 of the '763 patent recites patients suffering from osteoporosis as instantly claimed in claims 153-156.

The Examiner also stated that Black inherently anticipates claims 145-156 because

> In the instant case, it flows from the teachings of Black *et al.* that patients being treated with raloxifene so as to inhibit bone loss will naturally have a reduced likelihood of developing breast cancer. It is clear that Black *et al.* contemplate treating post-menopausal women with raloxifene and further contemplate treating patients having osteoporosis with raloxifene (i.e., the same patient populations as instantly claimed). Because the same patient populations are being treated with the same drug, the instantly claimed result of such treatment would naturally occur in the patients being treated in the '763 patent.

Black *et al.* discloses methods for inhibiting the loss of bone that results from a lack of

endogenous estrogen and the resulting osteoporosis, for example, post-menopausal osteoporosis.

In the sole independent claim pending, Claim 145 is directed to a "method for reducing the likelihood of incurring or developing estrogen-dependent breast cancer in a post-menopausal woman diagnosed as being in need of such therapy." (emphasis added). There is no discussion in Black about diagnosing or screening patients, who are to be administered raloxifene for osteoporosis, for breast cancer risk reduction or prevention. Applicants respectfully submit there is no teaching and no expectation that women who are so diagnosed represent all post-menopausal women. Applicants respectfully assert the present claims, therefore, do not flow from the teachings of Black. Therefore, Black does not anticipate the present claims.

Applicants point to the specification on page 15, lines 24-32 where "about 60 mg" is defined:

> Further, the dosage ranges delineated are based on the hydrochloride salt of the compound of formula I. Therefore, the 60 mg dose is equivalent to 55.71 mg of the free base. One of ordinary skill in the art will be able to calculate the free base equivalent of any salt of a compound of formula I which is pharmaceutically acceptable. For example, 'about' 60 mg would encompass 55 to 65 mg of raloxifene hydrochloride, while encompassing 51.73 to 60.35 mg of the free base.

Applicants submit that "about" does not expand the range of raloxifene to include any effective amount.

U.S.C. § 103(a) Rejection

Claims 19 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Black "as applied to claims 145-156." In the Office Action of April 11, 2008, the Examiner stated that

> Claim 19 is again rejected under 35 U.S.C. § 103(a) as being unpatentable over Black *et al.* (U.S. Patent No. 5,393,763; Issued Feb. 28, 1995) as applied to claims 145-156, supra. Black *et al.* disclose as applied *supra*.
>
> The reference does not explicitly disclose the instantly claimed administration for at least six months. However, in the absence of a showing of unexpected results, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to administer raloxifene for as long was necessary to inhibit bone loss as disclosed in Black *et al.* As such, because the same patient population is being administered the same active agent, it flows from the disclosure of Black *et al.* that such extended treatment will lead to a reduced likelihood of incurring or developing estrogen-dependent breast cancer in post-menopausal women.

It appears the Examiner has rejected claim 19 for being inherently obvious. In response

to the 103(a) rejection, Applicants, therefore, incorporate by reference the discussion above for the 35 U.S.C. § 102(b) rejection and again state that there is no discussion in Black about diagnosing or screening patients, who are to be administered raloxifene for osteoporosis, for breast cancer risk reduction or prevention. Applicants respectfully submit there is no teaching and no expectation that women who are so diagnosed represent all post-menopausal women. Applicants respectfully submit, therefore, that Claim 19 does not flow from the teachings of Black. Therefore, claim 19 is not obvious over Black.

Conclusion

Applicants submit claims 19 and 145-156 are ready for grant.

Respectfully submitted,

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